

REMARKS/ARGUMENTS

Claims 1-10 are pending in the application. Claims 11-20 have been previously withdrawn , claims 1-4 and claims 9-10 have been amended, new claim 21 has been added. No new matter has been added. Reconsideration of the claims is respectfully requested.

In paragraph 3 on page 2 of the Office Action, claims 1, 2 and 5-8 are rejected under 35 U.S.C. §102 (b) as being anticipated by US Patent No. 6,273,470 to Bullock.

In paragraph 5 on page 2 of the Office Action, claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bullock.

In paragraph 6 on page 3 of the Office Action, claims 4, 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bullock and US Patent No. 4867057 (Bradley et al.).

Amendments have been made to clarify the distinctions over the prior art and it is submitted that the claims as now presented are patentable thereover.

The Bullock patent is of course well known to the applicant. In that invention, the concept of slip resistance was introduced. The present invention is directed to the next significant improvement thereon, which is how to prevent the embossment from degrading the stock material. Of course, the greater the embossment depth, the more damage the embossing process will have on the stock material.

The examiner assert that the present inventor's own prior parent, Bullock '470 anticipates claims of the invention. This cannot be correct, at least with respect to the amended claims which clarify this ambiguity. The application of liquid polymer to the embossments, occurs **after** embossment and thus cannot be the basis for preventing breakdown of the stock layer fibers. It is simply too late to be of any help. The present inventor notes in Bullock '470 that the polymer material is to increase the tack of the

base layer. There is no mention at all of the problem (damage during embossment) and solution (creating a double layer which together is embossed).

The examiner has also asserted an obviousness (sec 103) rejection of the application on the basis of Bullock 470 with respect to claim 3. Again it is submitted that application of fibers after embossment does not solve the problem at hand. Polymers give strength to the stock material because they stretch better under deformation than stock materials. The bonded material undergoes less damage than the stock material alone. Our own '470 does not recognize this. Who would be the better test of what a person skilled in the art would know? The fact is that it would have been advantageous for the present inventor to include this feature in the 470 patent disclosure if it was merely an obvious variant. It's absence is a strong factor in favor of its non-obvious and is completely consistent with the ***Graham v. John Deere Co.***, 383 U.S. 1 (1966), secondary considerations tests, which has been confirmed in the current USPTO examiner's practice guidelines. (*See attachment Official Document of the USPTO dated 3 May 2007.*)

In *Graham*, the Court identified "secondary considerations" which could serve as indicia of nonobviousness. They include:

1. commercial success;
2. long-felt but unsolved needs; and
3. failure of others.

In this case, it was the failure of the present inventor to the present inventor himself, not to mention anyone else, to resolve a problem created by his own significant improvement (which became the '470 patent). At the moment he created the concepts embodied in the '470 patent, the problem of damage to stock material fibers was presented. If the solution was obvious, as it has been asserted by the examiner, he would have adopted it at the time and included it in the '470 patent. Therefore, the best test of obviousness in this case, is that the person most skilled in this art, did not even find a solution to the problem until many years after he himself created the problem.

Thus, the *Graham* test is not only helpful but applicable in reaching a finding of non-obviousness.

The examiner assert that Bradley et. al. can be combined with Bullock '470 to achieve the claimed combination of claims 4, 9 and 10. Bradley has been studied in detail. It is directed solely to the concept of creating decorative features on a greeting card or the like. It does, of course, disclose foil application. It does not however disclose the combination of foil and double layer resistance to tearing. The claims have been amended to reflect this distinction.

In view of the amendments and reasons provided above, it is believed that all pending claims are in condition for allowance. Applicant respectfully requests favorable reconsideration and early allowance of all pending claims.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicant's attorney of record, Michael B. Lasky at (952) 253-4106.

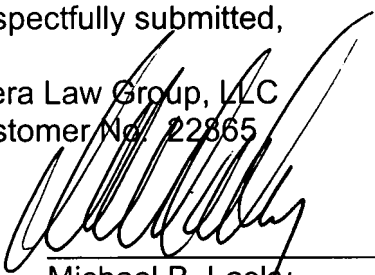
Respectfully submitted,

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Date:

11 June 2007

By:



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MEMORANDUM

DATE: May 3, 2007

TO: Technology Center Directors

FROM: *Margaret A. Focarino*
Margaret A. Focarino
Deputy Commissioner
for Patent Operations

SUBJECT: Supreme Court decision on *KSR Int'l. Co., v. Teleflex, Inc.*

The Supreme Court has issued its opinion in *KSR*, regarding the issue of obviousness under 35 U.S.C. § 103(a) when the claim recites a combination of elements of the prior art. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). A copy of the decision is available at <http://www.supremecourt.us/opinions/06pdf/04-1350.pdf>. The Office is studying the opinion and will issue guidance to the patent examining corps in view of the *KSR* decision in the near future. Until the guidance is issued, the following points should be noted:

(1) The Court reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

(2) The Court did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

(3) The Court rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. The Court specifically stated:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.**

KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.